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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,782	09/26/2003	Patrick Brouhon	1509-457	7891
<div>22879 7590 02/04/2008</div> <div>HEWLETT PACKARD COMPANY</div> <div>P O BOX 272400, 3404 E. HARMONY ROAD</div> <div>INTELLECTUAL PROPERTY ADMINISTRATION</div> <div>FORT COLLINS, CO 80527-2400</div>				
			EXAMINER	
			ZHU, RICHARD Z	
			ART UNIT	PAPER NUMBER
			2625	
			NOTIFICATION DATE	DELIVERY MODE
			02/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/670,782

Applicant(s)

BROUHON, PATRICK

Examiner

Richard Z. Zhu

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/20/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on applications EP 02354145.1 filed in European Patent Office on September 26th 2002. Certified copies of said European Application had been received.

Examiner's Suggestion

2. Regarding Claims 1-17, It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. The applicant is suggested to amend Claims 1-17 to recite a positive limitation.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C 112 that form the basis for the rejections under this section made in this office action:

[2nd Paragraph] The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16 are rejected under 35 USC 112 2nd Paragraph as failing to particularly pointing out and distinctly claiming the invention.

Independent Claim 1 recites "the spatial location of the indicia" without providing the proper antecedent basis for "the indicia" within the claim. Therefore, it is unclear to the examiner whether "the spatial location" and "the spatial location of the indicia" points to the same subject matter. Claims 2-16 are dependent upon Claim 1 and shows the same

deficiencies. Examination of Claim 1 will be on the basis of the meaning provided in Claim 17 where “the indicia” is properly defined.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 10-12, 14, and 16-17 are rejected under 35 USC 103 (a) as being unpatentable over *Testa et al. (US 6745186 B1)* in view of *Hicks (US 5359387 A)*.

Regarding Claim 1, *Testa* discloses a method of manipulating digitally stored images (Col 4, Row 65- Col 5, Row 4), the method including the steps of:

recording and storing digital representations of one or more images (Col 4, Rows 57-64);

transferring one or more of the plurality of digital images to a printer [capable of] generating representations of selected ones of the plurality of images (Col 5, Rows 5-25 and see Col 13, Rows 9-14);

the printer generating a proof-sheet (Fig 6A and see Col 7, Row 29-Col 8, Row 25) incorporating a graphical representation of at least one of the images (Col 7, Rows 29-34, pre-print sticker 80 on location 78 whereas the sticker is a graphical representation of the image that follows the proof sheet) and image manipulation user designation areas (Col

8, Rows 5-25), wherein the proof-sheet is further adapted to include location information which identifies any physical spatial location on the surface of the proof-sheet (Col 8, Rows 5-25, as it is very well known in the art as OCR, the spatial location of the handwritten instructions are identified and the handwritten instructions recognized so that designated image processing can proceed);

recording the spatial location of the indicia on the proof-sheet by using a pen that applies indicia to at least one of the user designation areas on the proof-sheet (Fig 6A and see Col 8, Rows 5-25, the spatial location of the handwritten instructions are identified and the handwritten instructions recognized so that designated image processing can proceed. Implicitly, a handheld stylus generally known as a pen is needed for handwritten entry of the instruction); and

transmitting the spatial location of the indicia to the printer (Col 13, Row 32 – Col 14, Row 30, transmitting the information including images and instruction sheet to the retailer over a communication line network where retailer's printers for processing the order are located).

Testa does not disclose the proof sheet incorporating at least one of a plurality of image selection.

Hicks discloses a proof sheet (Col 4, Rows 16-26, OCR readable proof sheet with handwritten customer instructions) incorporating at least one of a plurality of image selection (Fig 2 with customer instruction on the bottom and see Col 3, Rows 21-36).

It would've been obvious to one of ordinary skill in the art at the time of the invention to incorporate a proof sheet that comprises a plurality of image selection so as to visually aid

the customer in selecting the desired instructions by producing final positive photographic prints of a single subject from a plurality of varying photographic exposures of the subject representing varying poses (*Hicks*, Col 1, Row 66 – Col 2, Row 2).

Regarding Claim 2, *Testa* discloses causing the printer (retailer's printer) to translate the indicia spatial location into at least one of printing and image manipulation commands (Col 8, Rows 5-25).

Regarding Claim 3, *Testa* discloses wherein the indicia spatial location information and images are printed concurrently (Fig 23 and see Col 8, Rows 20-25, the images are processed or printed in accordance to the information provided at the spatial location. As such, the instruction is in essence printed with the images concurrently).

Regarding Claim 4, *Testa* discloses the step of printing the one or more images based on said indicia spatial location information (Col 8, Rows 20-25, the images are processed or printed in accordance to the information provided at the spatial location).

Regarding Claim 5, *Testa* discloses the step of printing the one or more images based on said indicia spatial location information (Col 8, Rows 20-25, the images are processed or printed in accordance to the information provided at the spatial location).

Regarding Claim 6, *Testa* discloses storing the one or more images stored on read/write capable media, the printer being adapted to receive the media therein to read the data stored thereon (Col 5, Rows 48-61 and see Col 13, Rows 59-65).

Regarding Claim 7, *Testa* discloses causing the printer to receive the media therein and read the data stored thereon (Col 5, Rows 48-61 and see Col 13, Rows 59-65).

Regarding Claim 10, *Testa* discloses wherein the position of the user-applied indicia are recorded by optically imaging the glyphs at the time that the indicia are applied (Col 8, Rows 5-25).

Regarding Claim 11, *Testa* discloses wherein data related to the position of the user-applied indicia are recorded by the pen (Fig 6A and see Col 8, Rows 5-25, the spatial location of the handwritten instructions are identified and the handwritten instructions recognized so that designated image processing can proceed. Implicitly, a handheld stylus generally known as a pen is needed for handwritten entry of the instruction), then transmitted to the printer (Col 13, Row 32 – Col 14, Row 30, transmitting the information including images and instruction sheet to the retailer over a communication line network where retailer's printers for processing the order are located).

Regarding Claim 12, *Testa* discloses wherein the data relating to the position of the user-applied indicia are transmitted to the printer substantially continuously, buffered for transmission or otherwise streamed (Col 13, Row 32 – Col 14, Row 30. As it is very well known for communication over the network where data transmitted are continuously transferred and buffered at the end location or otherwise streamed).

Regarding Claim 14, *Testa* discloses wherein the data are transmitted via a wireless link, a physical cable, or an optical link (Col 13, Rows 59-66).

Regarding Claim 16, *Hicks* discloses wherein the glyphs are printed on the proof-sheet substantially concurrently with the image representations (Col 3, Rows 21-28).

Regarding Claim 17, *Testa* discloses a digital image processing system (Fig 22) including:

a printer adapted to receive image data relating to one or more digital images taken by a user (Col 13, Row 32 - Col 14, Row 30, **inherently, there must be a printer at the retailer that prints both the proof sheet and the images as ordered so that proof sheet and its associated labels are printed and images are processed in accordance to user instruction**), the printer further adapted to produce a proof-sheet detailing the graphical images (Fig 6);

and a pen (Fig 6A and see Col 8, Rows 5-25, **the spatial location of the handwritten instructions are identified and the handwritten instructions recognized so that designated image processing can proceed. Implicitly, a handheld stylus generally known as a pen is needed for handwritten entry of the instruction**);

the paper and pen being arranged so that

(a) user-applied indicia corresponding to image manipulation commands applied by the user to the proof-sheet are adapted to be transmitted to the printer by recording the spatial position of the user-applied indicia (Col 13, Row 32 – Col 14, Row 30, **transmitting the information including images and instruction sheet to the retailer over a**

communication line network where retailer's printers for processing the order are located) and

(b) the recorded spatial position of the user-applied indicia are adapted to be transmitted to the printer (**Col 13, Row 32 – Col 14, Row 30, inherently, there must be a printer at the retailer that prints both the proof sheet and the images as ordered so that proof sheet and its associated labels are printed and images are processed in accordance to user instruction**).

7. Claims 8-9 and 15 are rejected under 35 USC 103 (a) as being unpatentable over the combined teachings of *Testa et al. (US 6745186 B1)* and *Hicks (US 5359387 A)* in view of *Jared et al (US 6208771 B1)*.

Regarding Claim 8, the combined teaching does not disclose wherein the sheet has a plurality of glyphs that provide position information to the pen, and communicating said position information to the printer.

Jared discloses wherein the sheet has a plurality of glyphs that provide position information to the pen, and communicating said position information to a data processing apparatus (**Col 11, Rows 32-54, the data processing apparatus being a computer that collects the glyph position information via the pen**).

It would've been obvious to one of ordinary skill in the art at the time of the invention to adapt a stylus pen that can transmit cursive handwritten glyphs to a data processing apparatus such as a computer or printer in order to accurately and conveniently transmit a

plurality of handwritten instructions to the data processing apparatus so that user's desired orders are processed.

Regarding Claim 9, *Jared* discloses wherein the position of the pen is detected using a position location system based on infra-red detection, electromagnetic spatial orientation (Col 12, Rows 1-23, **glyph orientation detection via scanning, which involves electromagnetic spectrum analysis of the light reflected off the surface**) or the like.

Regarding Claim 15, *Jared* discloses wherein the data are transmitted to the printer at the instigation by a user activating a switch or sensor on the pen (Col 11, Rows 46-53).

8. Claim 13 is rejected under 35 USC 103 (a) as being unpatentable over the combined teachings of *Testa et al. (US 6745186 B1)* and *Hicks (US 5359387 A)* in view of *Chai (US 6393138 B1)*.

Regarding Claim 13, the combined teaching does not disclose wherein the data relating to the position of the user-applied indicia are transmitted using a wireless communication means.

Chai discloses a system that employs a wireless stylus for OCR (See **Background, Col 1-2**) wherein data relating to the position of the user-applied indicia are transmitted using a wireless communication means (Col 2, Rows 40-48).

It would've been obvious to one of ordinary skill in the art at the time of the invention to adapt a wireless means for transmitting spatial location information in order to provide the user with a convenient apparatus without the draw backs of a wired system, such as hardware interface and burden of technical knowledge to properly connect the apparatus to a data processing apparatus such as a printer or a computer.

Conclusion

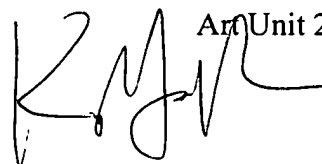
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 4441807 A, US 6017157 A, and US 6697165 B2 discloses generating proof sheets and OCR apparatus for recognizing handwritten user instructions on the proof sheet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner's supervisor King Y. Poon whose telephone number is 571-272-7440 or examiner Richard Z. Zhu whose telephone number is 571-270-1587. Examiner Richard Zhu can normally be reached on Monday through Thursday, 6:30 - 4:00 and alternate Friday, 7:30-4:00.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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12/27/2007

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